



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/542,139

04/04/2000

Satoru Yukie

50 P 3859.02

6059

36738

7590

07/13/2009

ROGITZ & ASSOCIATES  
750 B STREET  
SUITE 3120  
SAN DIEGO, CA 92101

EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

07/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2  
3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* SATORU YUKIE, GINA C. EUBANKS, and KEN AOKI  
9

10  
11 Appeal 2008-004698  
12 Application 09/542,139  
13 Technology Center 3600  
14

15  
16 Decided:<sup>1</sup> July 13, 2009  
17

18  
19 *Before* ALLEN R. MACDONALD,<sup>2</sup> *Vice Chief Administrative Patent*  
20 *Judge*, MURRIEL E. CRAWFORD, and HUBERT C. LORIN,  
21 *Administrative Patent Judges*.

22  
23 CRAWFORD, *Administrative Patent Judge*.  
24

25  
26 DECISION ON APPEAL

---

<sup>1</sup>The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

<sup>2</sup> Judge Allen R. MacDonald replaces Judge David B. Walker who was on the original panel.

1 The original Decision entered February 27, 2009 is hereby  
2 VACATED due to a clerical error noted on page 6 with regards to claim 24.  
3 We hereby enter a new Decision on Appeal to correct this error.  
4

5 STATEMENT OF THE CASE

6 Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection  
7 of claims 1 to 5, 8, 10, 12 to 17, 22, 24, 26, and 29 to 35. We have  
8 jurisdiction under 35 U.S.C. § 6(b) (2002).

9 Appellants invented a computer system having at least one connect  
10 server accessing a database of publicly vended content to fulfill requests and  
11 at least one billing module for generating accounting data based on at least  
12 one of a request for content received, each piece of content delivered, a  
13 content subscription, a type of user terminal and a number of IP packets  
14 delivered (Specification 4).

15 Claim 1 under appeal reads as follows:

- 16 1. A computer system, comprising:  
17 a computer network path, at least a portion of which is  
18 wireless:  
19 at least one user terminal in the path;  
20 at least one connect server communicating with the user  
21 terminal, the connect server receiving requests for content  
22 generated from the user terminal, the connect server accessing a  
23 database of publicly vended content to fulfill the requests; and  
24 at least one billing module accessible to the connect  
25 server for generating accounting data based on at least one of:  
26 each request for content received, each piece of content  
27 delivered to the user terminal, a content subscription, a type of  
28 user terminal, and a number of IP packets delivered to the user  
29 terminal.  
30

1 Claim 12 under appeal reads as follows:

2 12. A method for vending content, comprising the acts of:  
3 rendering the content in a digitized format;  
4 making the content available on a computer network;  
5 establishing at least one network path between the  
6 network and a user terminal, at least a portion of the path being  
7 a private wireless path;  
8 sending the content to the user terminal via the network  
9 path; and  
10 generating accounting data representative of the  
11 provision of content to the user terminal; wherein the  
12 accounting data is based on at least one of:  
13 a number of packets delivered to the user terminal; and  
14 a type of the user terminal.  
15

16 The Examiner rejected claims 1 to 5, 8, 10, 12 to 17, 22, 24, 26, and  
17 29 to 35 under 35 U.S.C. § 102(b) as being anticipated by Hylton.<sup>3</sup>

18 The prior art relied upon by the Examiner in rejecting the claims on  
19 appeal is:

20 Hylton US 5,708,961 Jan. 13, 1998

21

22 ISSUES

23 Have Appellants shown that the Examiner erred in finding that Hylton  
24 discloses a connect server as required by claim 1?

25 Have the Appellants shown that the Examiner erred in finding that  
26 Hylton discloses a method including the step of generating accounting data

---

<sup>3</sup>Claim 29 does not appear to comply with the requirements of 35 U.S.C. § 112, second paragraph because the claim is dependent on a canceled claim. In the event the Appellants decide to further prosecute the application before the Examiner, a correction should be made.

1 based on at least one of a number of packets delivered to the user terminal  
2 and the type of user terminal as required by claim 12?  
3

4 FINDINGS OF FACT

5 FF 1. Hylton discloses a computer system comprising a computer  
6 network path for providing broadband signals to a number of set top boxes  
7 or user terminals 100 (col. 4, ll. 54 to 57; Figure 1). The system distributes  
8 signals utilizing wireless transmission between a shared processing system  
9 10 and the user terminals 100 (col. 4, ll. 57 to 60). The shared processing  
10 system 10 is connected to and receives a plurality of channels from a digital  
11 broadband network 5 (col. 5, ll. 41 to 42). For each user terminal on the  
12 system there is a channel selector and a program selector (col. 5, ll. 58 to  
13 60). The shared processing system 10 supplies broadband signals to a  
14 number of user terminals. Hylton does not disclose that broadband network  
15 5 includes a server or that broadband network 5 communicates with user  
16 terminals 100 or accesses a billing module.

17 FF 2. Hylton discloses that billing for the broadband content may  
18 take place using a subscription process or a pay per view process (col. 40, ll.  
19 38 to 48; col. 27, ll. 12 to 14). Hylton discloses that a service profile is  
20 created for each customer and their set top box and is stored in a level 1  
21 gateway and that the level 1 gateway may provide interface to appropriate  
22 billing systems (col. 26, ll. 9 to 15). Hylton does not disclose that billing is  
23 based on the number of packets delivered or the type of user terminal or that  
24 the broadband network accesses a billing module.  
25

1 PRINCIPLES OF LAW

2 To support a rejection of a claim under 35 U.S.C. § 102(b), it must be  
3 shown that each element of the claim is found, either expressly described or  
4 under principles of inherency, in a single prior art reference. *See Kalman v.*  
5 *Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983), *cert. denied*, 465  
6 U.S. 1026 (1984).

7  
8 ANALYSIS

9 We will not sustain the Examiner's rejection because the Examiner  
10 has not shown that each element of claims 1 and 12 is found expressly or  
11 under principles of inherency in the Hylton reference.

12 In regard to claim 1, the Examiner finds that the broadband network 5  
13 is a connect server as recited in claim 1 (Answer 4). As found above,  
14 Hylton's broadband network 5 does not communicate with a user terminal or  
15 a billing module. As such, broadband network 5 is not a connect server as  
16 recited in claim 1. Hylton does not anticipate the subject matter of claim 1  
17 and claims 2 to 5, 8, 10, 31, and 33 dependent thereon.

18 As such, we will not sustain this rejection as it is directed to claims 1  
19 to 5, 8, 10, 31, and 33.

20 In regard to claims 12 and 26, we note that the customer in Hylton is  
21 billed based on a subscription or on a pay per view basis. Although the  
22 content sent to the user terminals may be sent in IP packets, there is no  
23 disclosure that accounting is based on the IP packets. In addition, while  
24 Hylton discloses that each user has a profile that includes a description of the

1 terminal type, there is no disclosure in Hylton that the accounting data is  
2 based on the terminal type.

3 Therefore, we will not sustain this rejection as it is directed to claims  
4 12 and 26 and claims 13 to 17, 22, 32, and 34 which are dependent on claim  
5 12.

6 We will sustain this rejection as it is directed to independent claim 24  
7 because this claim in reciting “at least one of” in line 7 only requires a  
8 means for billing a user which includes a means for generating accounting  
9 data based at least in part on a content subscription or on a request. Hylton  
10 clearly shows that billing is based on a content subscription or on a pay per  
11 view, i.e., based on a request. We will also sustain the rejection as it is  
12 directed to claims 29 to 30 and 35 because the Appellants have not argued  
13 the separate patentability of these claims.

14  
15 **CONCLUSION OF LAW**

16 On the record before us, Appellants have shown that the Examiner  
17 erred in finding that Hylton anticipates the subject matter of claims 1 to 5, 8,  
18 10, 12 to 17, 22, 26, and 31 to 34.

19 On the record before us, Appellants have not shown that the Examiner  
20 erred in finding that Hylton anticipates the subject matter of claims 24, 29,  
21 30, and 35.

